

### REMARKS

The applicant has carefully considered the official action dated August 7, 2009, and the references it cites. By way of this response, claims 1 and 14 have been amended. Claim 17 has been added. No new matter has been introduced. In view of the following, it is respectfully submitted that all pending claims are in condition for allowance and favorable reconsideration is respectfully requested.

### The 35 U.S.C. §103(a) Rejections

Claims 1-16 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Yoon (U.S. Patent 5,954,731) in view of Tovey (U.S. Patent 5,643,294). The applicant respectfully submits that the pending claims are allowable for at least the reasons set forth below.

#### CLAIM 1

Independent claim 1 is directed to a surgical instrument that includes, *inter alia*, an instrument handle and a first manipulator in the shape of a rotary knob being rotatably supported at a front end of the instrument handle, where both the instrument handle and the rotary knob are aligned so as to be laterally offset with respect to a tube shaft.

The Office admits that Yoon fails to describe a rotary knob being rotatably supported on the handle member. *See* present action at page 3. Therefore, Yoon fails to describe an instrument handle and a first manipulator in the shape of a rotary knob being rotatably supported at a front end of the instrument handle, where both the instrument handle and the rotary knob are aligned so as to be laterally offset with respect to a tube

shaft.

Tovey describes a surgical apparatus with a rotation knob 32 that is not laterally offset with respect to a tube shaft. Therefore, Tovey also fails to describe an instrument handle and a first manipulator in the shape of a rotary knob being rotatably supported at a front end of the instrument handle, where both the instrument handle and the rotary knob are aligned so as to be laterally offset with respect to a tube shaft.

As discussed above, none of the cited portions of the prior art describe an instrument handle and a first manipulator in the shape of a rotary knob being rotatably supported at a front end of the instrument handle, where both the instrument handle and the rotary knob are aligned so as to be laterally offset with respect to a tube shaft. Therefore, the combinations of Yoon and Tovey used as the bases for the obviousness rejections do not teach or suggest all of the recitations of the claims. “To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.” M.P.E.P. 2143.03. “All of the words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Royka*, 490 F.2d 981 (C.C.P.A. 1974). Consequently, the obviousness rejection for claim 1 and any of its dependent claims cannot stand and the claims are in condition for allowance.

#### CLAIM 14

Independent claim 14 is directed to a surgical instrument that includes, *inter alia*, an instrument handle including a first manipulator configured to effect bending of an instrument head that is formed between a front end of the instrument handle and a rear end of the instrument handle having a free end and a second manipulator including an

operating element having the shape of a rotary knob and being rotatably supported at the free end of the first manipulator of the instrument handle opposite to the linkage with the tube shaft.

As noted above, the office admits that Yoon fails to describe the claimed rotary knob. Thus, Yoon fails to describe an instrument handle including a first manipulator configured to effect bending of an instrument head that is formed between a front end of the instrument handle and a rear end of the instrument handle having a free end and a second manipulator including an operating element having the shape of a rotary knob and being rotatably supported at the free end of the first manipulator of the instrument handle opposite to the linkage with the tube shaft.

Furthermore, the rotation knob 32 of Tovey is located at the rear of the supposed handle 12, but not at a free end of a first manipulator (i.e., at the free or bottom ends of the scissor-like handles shown in FIG. 1 of Tovey). Thus, Tovey also fails to describe an instrument handle including a first manipulator formed between a front end of the instrument handle and a rear end of the instrument handle having a free end and a second manipulator including an operating element having the shape of a rotary knob and being rotatably supported at the free end of the first manipulator of the instrument handle opposite to the linkage with the tube shaft. Furthermore, in Tovey, the scissor-like handle 46 are used to open/close the jaw members 26, 28, not for bending the instrument head.

In addition, combining Yoon and Tovey would result in a structure with the rotation knob 32 either at the end of the shaft 10 in Yoon and, thus, not at the free end of the scissor-like handle (i.e., elements 68, 72) or at the end of the handles 68, 72 but not

opposite the linkage with the tube shaft. Therefore, combining both Yoon and Tovey would result in a structure lacking an instrument handle including a first manipulator configured to effect bending of the instrument head that is formed between a front end of the instrument handle and a rear end of the instrument handle having a free end and a second manipulator including an operating element having the shape of a rotary knob and being rotatably supported at the free end of the first manipulator of the instrument handle opposite to the linkage with the tube shaft.

For at least this reason, the obviousness rejection of claim 14 cannot stand, and the claim is in condition for allowance.

#### CLAIM 17

Independent claim 17 is directed to a surgical instrument that includes, *inter alia*, an instrument handle including a first manipulator comprising an actuator shaft having a longitudinal axis and a second manipulator coupled to the first manipulator along the longitudinal axis of the first manipulator, wherein the second manipulator comprises a rotary knob rotatable about the longitudinal axis of the first manipulator.

Neither Yoon nor Tovey describes a handle with two manipulators, one of which is an actuator shaft and the other of which is a rotary knob rotatable about the longitudinal axis of the actuator shaft. Thus, claim 17 is allowable.

#### **Conclusion**

Based on the foregoing remarks, it is respectfully submitted that all claims are in condition for allowance. If the examiner is of the opinion that a telephone conference

**U.S. App. Serial No. 10/815,395**  
**Response to Office Action Dated August 7, 2009**

would expedite the prosecution of this case, the examiner is invited to contact the undersigned (312) 580-1020.

No fee is due, however, the Commissioner is hereby authorized to charge any deficiency in the amount enclosed or any additional fees which may be required under 37 CFR 1.16 or 1.17 to Deposit Account No. 50-2455. Please refund any overpayment to Hanley, Flight & Zimmerman, LLC at the address below.

Respectfully submitted,  
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**October 7, 2009**

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